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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,563	04/19/2001	Jean-Marie Gatto	CYBS5748	8750

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YOUNG LAW FIRM  
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PORTOLA VALLEY, CA 94028

EXAMINER
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JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 11/18/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/838,563

Applicant(s)

GATTO ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 59-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the amendment filed on August 28, 2003 in which applicant amends claims 1, 2, 15, 23, 31, 40, 41, 45, 48, 49, 52, 55, and 56, amends the specification, corrects and submits replacement drawings for figures 1, 2, 3, and 7, and responds to the claim rejections.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 6-7, 9-34, 36, 38, and 40-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright (U.S. 3,645,531).

Wright discloses a gaming machine that provides a display of a horse race that is divided into four subframes randomly selected from endless film of horse races, wherein bets can be made and winnings paid out in accordance with the outcome of the race. Wright additionally discloses:

Regarding Claims 1, 15, 21, 23, 29, 31, 32, 34, 45, 50, 52, and 57:

- a display (29) (figure 1);
- a library of selectably accessible video sequences, the library including a plurality of activity sets, each activity set of the plurality of activity sets being associated with a different activity, each activity set including a plurality of sequentially

numbered subsets, each numbered subset including a plurality of like numbered video sequences drawn to the associated activity (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6); multiple film/video sequences are randomly chosen to be displayed.

- a player interaction means (coin slots **31-34**), the player interaction means being configured to enable selection of at least an activity, a predicted numbered outcome of the selected activity and a wager on the predicted number outcome of the selected activity (figure 1, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6);
- a random number generator (**83**) (figure 10a);
- a processor, the processor being configured to access the library and to select an activity set associated with the activity selected by the player to select one of the sequentially numbered subsets according to a selected number generated by the random number generator and to access and show one of the plurality of like numbered video sequences of the selected subset on the display (figure 10a, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

Regarding Claims 2, 16, 24, 33, 46, and 53:

- the player interaction means configured to pay a predetermined sum when the predicted numbered outcome matches an actual outcome of the selected activity shown in the accessed one of the plurality of like numbered video sequences of the selected subset (abstract, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

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Regarding Claims 4 and 36:

- the library is stored locally relative to the processor (abstract, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6) .

Regarding Claims 6, 19, and 27:

- the associated activity (horse race) is a competitive activity in which a single numbered entrant is declared the winner (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

Regarding Claims 7 and 38:

- the entrant includes at least one of a human, an animal, or a machine (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

Regarding Claims 9 and 40:

- the associated selected activity includes a sport (horse racing) (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6)).

Regarding Claims 10 and 41:

- the associated selected activity is a race (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

Regarding Claim 11:

- the predetermined sum is determined according to the wager and predetermined odds (abstract, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

Regarding Claims 12, 18, 26, 42, 48, and 55:

- the library includes an introductory video sequence for each activity set and wherein the system is configured to show the introductory video sequence on the display immediately prior to the accessed one of plurality of like numbered video sequences (column 6, lines 8-20). A player can submit a wager on a horse that has not been selected up until the final sequence of four is shown. Therefore, the first three sets are shown prior to the last sequence.

Regarding Claims 13 and 43:

- the player interaction means is disabled when the introductory video sequence is shown on the display (column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6). A player's coin is rejected once a bet has already been placed on a horse or one of the four video sequences has begun.

Regarding Claims 14 and 44:

- the player interaction means includes a button (37) (start button) (figure 1).

Regarding Claims 17, 25, 47, and 54:

- the selected actual outcome is independent of the predicted outcome and of any action or knowledge of the player (abstract, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6). The race is purely random, just like a true slot machine.

Regarding Claims 20, 28, 49, and 56:

- the race is selected from the group including a horse race, a dog race, a swimming race, a skiing race, a car race, a motorcycle race, a bicycle race, and a boat race (column 6, lines 41-45).

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Regarding Claims 22, 30, 51, and 58:

- the wager is a singles bet (abstract, column 1, line 1-column 2, line 7, and column 2, line 24-column 7, line 6).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5, 8, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (U.S. 3,645,531).

Wright discloses that as discussed above regarding Claims 1-2, 4, 6-7, 9-34, 36, 38, and 40-58. However, Wright seems to lack explicitly stating:

Regarding Claims 3 and 35:

- the library is stored remotely from the player interaction means and wherein the library is accessed over a computer network.

Regarding Claims 5 and 37:

- the locally stored library is coupled to a computer network to enable remote updating of the library over the network.

Regarding Claims 8 and 39:

- the numbered entrant is a team.

However, to one having ordinary skill in the art at the time of Applicant's invention, using network and network server technology was notoriously well known. It would have been

obvious to one having ordinary skill in the art at the time of Applicant's invention to implement Wright's invention on a computer network. One would be motivated to do so to implement Wright's game in the state of the art technology.

Regarding Claims 8 and 39, it would have been obvious at the time of Applicant's invention to simulate a human 4 X 100 meter relay race in Wright. It would have been obvious to simulate a human 4 X 100 meter relay race in Wright because Wright discloses four separate film/video sequences are incorporated into the game. Hence, each one of the four video sequences could represent each of the four legs of the relay race.

#### ***Response to Arguments***

6. Applicant's arguments filed August 28, 2003 have been fully considered but they are not persuasive.

7. Applicant's arguments, see page 2, filed August 28, 2003, with respect to the specification has been fully considered and are persuasive. The objection of the specification has been withdrawn.

8. Applicant's arguments, see page 16 and replacement figures 1, 2, 3, and 7, filed August 28, 2003, with respect to the figures have been fully considered and are persuasive. The objection of figures 1, 2, 3, and 7 has been withdrawn.

9. Applicant requests reconsideration and withdrawal of the rejection to claims 1-2, 4, 6-7, 9-34, 36, 38, and 40-58 under 35 U.S.C. 102(b) as being anticipated by Wright (U.S. 3,645,531). Applicant alleges Wright does not disclose "a plurality of activity sets" each associated with a different activity. The examiner respectfully disagrees. The examiner asserts Wright discloses at least two separate sequences for each race. Therefore, if subframes 18, 19, 20, and 21 bear



images of four possible variations of a race, then there are at least eight activity sets (beginning and ending sequences of a race) which are chosen from the four subframes. Therefore, the examiner believes Wright anticipates the claims.

10. Applicant alleges Wright does not disclose “any player interaction means configured to allow a player to select an activity associated with one of the plurality of activity sets.” The examiner respectfully disagrees. The player places a bet (in one of coin slots 31-34) to select a horse to win the horse race. Therefore, the examiner believes Wright anticipates the claims.

11. Applicant alleges Wright does not “enable the player to choose between a horse, dog, powerboat, or skiing races as the claimed invention.” The examiner respectfully disagrees, as claimed, the examiner need only find a reference that discloses one of these races, such as, a horse race. Furthermore, as previously stated, Wright discloses alternative embodiments showing races other than horse races, such as, motor races or dog races, etc. Therefore, the examiner believes Wright anticipates the claims.

12. Applicant alleges Wright does not disclose “a video library” and that Wright’s apparatus “is one film sequence per randomly selected winner.” The examiner respectfully disagrees. As previously stated above and disclosed in column 1, Wright’s race consists of at least two sequences (beginning and ending sequences of a race) which are randomly selected from at least four separate variations of the race. In column 1, Wright discloses each of the at least two sequences are composed to form a simultaneous or sequentially coherent scene (race). That way, when different portions of different races are randomly selected to be displayed, the race will seem coherent, natural, or appear to be displayed from a single film or video. Therefore, each of

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Wright's at least four variations of a race, in film or video form, comprise a library. Therefore, the examiner believes Wright anticipates the claims.

13. Regarding the rejection to claims 3, 5, 8, 35, 37, and 39 under 35 U.S.C. 103(a) as being unpatentable over Wright (U.S. 3,645,531), applicant acquiesces to the rejection by virtue of not responding to the rejection.

14. For the reasons discussed hereinabove, the rejections stated in Office Action, Paper No. 9 are retained and incorporated herein.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. This application contains claims 59-75 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-930~~2~~<sup>6</sup>.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ  
sej

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700